

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S) : Benco et al.  
TITLE : **NETWORK SUPPORT FOR  
FORWARDING INCOMING FAX  
CALL TO MOBILE FAX DEVICE**  
APPLICATION NO. : 10/762,011  
FILED : January 21, 2004  
CONFIRMATION NO. : 4490  
EXAMINER : Ekong, Emem  
ART UNIT : 2688  
LAST OFFICE ACTION : February 14, 2006  
ATTORNEY DOCKET NO. : LUTZ 2 00283, Case Name/No.  
Benco 46-34-34-39-34  
:

**RESPONSE TO THE FINAL OFFICE ACTION DATED FEBRUARY 14, 2006**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Favorable reconsideration of the above-identified application is respectfully requested in view of the following remarks.

### **REMARKS**

The Final Office Action dated February 14, 2006 has been received and carefully reviewed, wherein Applicants note with appreciation the indication that the correction made in the abstract has been accepted. The Office Action finally rejected claims 1-20 on obviousness grounds. Applicants respectfully request reconsideration of the pending claims 1-20 in view of the following remarks.

#### **I. REJECTION OF CLAIMS 1, 2, 9-11, 16, 17, AND 20 UNDER 35 U.S.C. §103**

Claims 1, 2, 9-11, 16, 17, and 20 were rejected under 35 U.S.C. §103 as being unpatentable over Joong 6,134,433 in view of Christensen 6,188,758. For at least the following reasons, reconsideration and withdrawal of these claim rejections is respectfully requested. There is no suggestion, motivation, or reasonable expectation of success for attempting the proposed combination of Joong with Christensen. In this regard, no teaching has been found within the references themselves and no other evidence has been presented which provide the requisite motivation for a modification thereof in accordance with the claimed invention. Reconsideration and withdrawal of the rejections of claims 1, 2, 9-11, 16, 17, and 20 is therefore requested under 35 U.S.C. §103.

A *prima facie* showing of obviousness requires some suggestion or motivation in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one skilled in the art to modify a reference or to combine references. MPEP §2143.01, citing to In re Kotzab, 217 F.3d 1365, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988). Motivation for combining references or modifying references may come from explicit statements in the art, implicit teachings therein, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. In re Thrift, 298 F.3d 1357, 1363, 63 U.S.P.Q.2d (BNA) 2002 (Fed. Cir. 2002). However, the showing of such suggestion or motivation must be clear and particular, rather than based on conclusory rationale. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002); In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d (BNA) 1614 (Fed. Cir. 1999). In addition, there must be a reasonable expectation of success in making the proposed modification or combination. MPEP §2143.02, See also Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 56 U.S.P.Q.2d (BNA) 1456 (Fed. Cir. 2000). Furthermore, the mere fact that

references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01, citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 1990); In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d (BNA) 1780 (Fed. Cir. 1992). Moreover, where a proposed modification or combination of the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 citing to In re Gordon, 733 F.2d 900, 221 U.S.P.Q. (BNA) 1125 (Fed. Cir. 1984). When the cited references to Joong and Christensen are viewed in light of the above standard, no suggestion, motivation, or reasonable expectation of success is found for attempting the proposed combination of Joong with Christensen, whereby claims 1, 2, 9-11, 16, 17, and 20 are non-obvious under 35 U.S.C. §103.

Independent claim 1 and dependent claims 2 and 9-11 involve methods for a wireless network to forward an incoming call to a subscriber's primary mobile directory number on to a mobile fax directory number assigned to the subscriber. These methods include associating the subscriber's mobile fax directory number with the subscriber's primary mobile directory number, and determining whether an incoming call to the subscriber's primary mobile directory number is a fax call. If the incoming call is a fax call, the incoming call is *forwarded* to the subscriber's mobile fax directory number, and otherwise, the incoming call is *connected* to the subscriber's primary mobile directory number. Independent claim 16 and associated dependent claims 17 and 20 are directed to wireless networks for forwarding an incoming call to a subscriber's primary mobile directory number on to a mobile fax directory number assigned to the subscriber. The wireless network of claim 16 includes means for associating the subscriber's mobile fax directory number with the subscriber's primary mobile directory number, means for determining whether the incoming call is a fax call, and means for *forwarding* the incoming call to the subscriber's mobile fax directory number if the incoming call is a fax call, and *connecting* the incoming call to the subscriber's primary mobile directory number if the incoming call is not a fax call. The subject matter of these claims therefore involves *forwarding of fax calls and connection of non-fax calls*.

The Joong reference, on the other hand, is directed to a forwarding system in a radio telecommunications network that *forwards* voice calls to a first transfer number and *forwards* data calls to a second transfer number. Joong, therefore, forwards both data and non-data calls and fails to disclose connecting incoming non-fax calls to the

subscriber's primary mobile directory number, as acknowledged in the Office Action. Christensen appears directed to a semi-manual call forwarding system. The background portion of Christensen cited to in the Office Action (e.g., col. 1, lines 31-45) appears directed to a microprocessor-based interface device that *connects* incoming calls to a telephone, and answering machine, or a telefax machine, depending on the type of traffic detected, and thus does not appear to involve forwarding at all. These references are much different than the claimed inventions, in which an incoming call is either *connected* to a subscriber's primary mobile DN (non-fax calls to the primary mobile DN) or *forwarded* to subscriber's mobile fax DN (fax calls to the primary mobile DN), wherein the connection of non-fax calls in the claimed methods and systems is not a forwarding operation.

With respect to independent claim 1, the Office action proposes at page 4 to "modify the method of Joong, and have incoming call that is not a fax call forwarded to the subscriber's primary mobile directory number as disclosed by Christensen for purposes of performing automatic or manual call forwarding services". This proposed combination is flawed for several reasons. First, the method of claim 1 does not "forward" non-fax calls. Second, with respect to the non-fax-call connection aspects of claim 1, the system of Joong is a *forwarding* system that operates only when the called mobile station is not available to take the incoming call (col. 2, line 60 through col. 3, line 37). Thus, a person of ordinary skill in the art, upon studying the teachings of Joong, would conclude that modification of the Joong system to connect non-fax calls to the called mobile station would render the resulting system inoperable for its intended purpose, i.e., for *forwarding* voice calls to a first transfer number and forwarding data calls to a second transfer number when the primary mobile is unavailable. In this regard, the nature of the Joong and Christensen disclosures appear to teach away from the combination proposed in the Office Action. Thirdly, the system of Christensen appears to involve the subscriber making a decision as to where to forward an incoming call at the time the call comes in, and is thus a manual redirection scheme (SEE steps 4-6 of Christensen at col. 3, line 59 through col. 4, line 22). Consequently, Christensen is not properly combinable with an automatic forwarding system as set forth in Joong, and would be understood as rendering Joong inoperable by a person of ordinary skill in the art. Moreover, the Office Action at page 4 indicates that motivation for this proposed combination is for the purpose of performing automatic or manual call

forwarding services, whereas the invention of independent claim 1 does not involve manual call forwarding at all.

With respect to independent claim 16, the Office Action asserts on page 7 that it would have been obvious "to modify the invention of Joong and have the incoming call to the subscriber's primary mobile directory number if the incoming call is a fax call as disclosed by Christensen *for the purpose of call forwarding*." As stated above, and as clearly set forth in claim 16, the invention involves means for *connecting* the incoming call to the subscriber's primary mobile directory number if the incoming call is not a fax call, wherein the connection of non-fax calls in claim 16 is not a forwarding operation. Therefore, the Office Action fails to state a valid reason for attempting the proposed combination with respect to claim 16, and thus no prima facie showing of obviousness has been made. Applicants therefore respectfully submit that there is no suggestion, motivation, or reasonable expectation of success in the proposed combination of Joong with Christensen, whereby claims 1, 2, 9-11, 16, 17, and 20 are patentably distinct therefrom and reconsideration of these claims is requested under 35 U.S.C. §103.

## **II. REJECTION OF CLAIMS 3-5, 13, AND 14 UNDER 35 U.S.C. §103**

Claims 3-5, 13, and 14 were rejected on pages 9-10 and 18-19 under 35 U.S.C. §103 as being obvious in view of Joong 6,134,433 in combination with Christensen 6,188,758 and further in view of Henrick 6,151,137. As stated above, there is no motivation, suggestion, or reasonable expectation of success in combining Joong with Christensen with respect to independent claim 1 from which claims 3-5 depend. Henrick fails to provide such motivation, whereby the subject matter of claims 3-5 is patentably distinct from the proposed combination of Joong with Christensen and Henrick. Accordingly, Applicants request reconsideration and withdrawal of the rejections of claims 3-5 under 35 U.S.C. §103.

Claims 13 and 14 depend from independent claim 12, which recites a method for a wireless network to forward an incoming call to a subscriber's mobile fax directory number, including among other steps, forwarding incoming fax calls to the subscriber's mobile fax directory number and connecting non-fax incoming calls to the subscriber's primary mobile directory. Thus, claim 12 and dependent claims 13 and 14 involve *forwarding fax calls and connecting non-fax calls*. For the reasons set forth above in connection with independent claims 1 and 16, Applicants submit that no motivation, suggestion, or reasonable expectation of success exists for the proposed combination

of Joong with Christensen in relation to claims 13 or 14, and Henrick fails to provide such motivation. Consequently, claims 13 and 14 are also non-obvious with respect to the proposed combination of Joong with Christensen and Henrick and reconsideration thereof is respectfully requested under 35 U.S.C. §103.

### **III. REJECTION OF CLAIMS 6, 12, AND 18 UNDER 35 U.S.C. §103**

Claims 6, 12, and 18 were rejected under 35 U.S.C. §103 as being obvious in view of Joong 6,134,433 in combination with Christensen 6,188,758 and further in view of Henrick 6,151,137 and Denker 6,404,513. Applicants respectfully submit that these claims are patentably distinct from the proposed combination of Joong with Christensen, Henrick, and Denker and request reconsideration and withdrawal of these rejections for at least the following reasons.

Rejected claim 6 depends from independent claim 1 discussed above in connection with Joong and Christensen. As previously noted, there is no motivation, suggestion, or reasonable expectation of success in attempting to combine Joong and Christensen in the manner proposed with respect to claim 1, wherein a person of ordinary skill in the art would avoid such an attempt as rendering the resulting system inoperable for the call forwarding purposes described in Joong. As discussed above, moreover, Henrick fails to provide the required suggestion for this combination. Denker likewise provides no suggestion, motivation, or reasonable expectation of success in combining the teachings of Joong with those of Christensen. Applicants therefore submit that claim 6 is patentably distinct from any combination of Joong and Christensen, whereby reconsideration and withdrawal of the rejection thereof is respectfully requested.

The method of independent claim 12 includes *forwarding* incoming fax calls to the subscriber's mobile fax directory number and *connecting* non-fax incoming calls to the subscriber's primary mobile directory, for which there is no motivation, suggestion, or reasonable expectation of success in attempting to combine Joong and Christensen. For at least this reason, therefore, claim 12 is non-obvious over the proposed combination of Joong, Christensen, Henrick, and Denker, and reconsideration thereof is requested under 35 U.S.C. §103.

Claim 18 depends from independent claim 16 discussed above, where no prima facie showing of obviousness has been made with respect to suggestion, motivation, and reasonable expectation of success with respect to Joong and Christensen. The

addition of Henrick and Denkar does not provide and such motivation, whereby dependent claim 18 is also patentable over the proposed combination of Joong with Christensen, Henrick, and Denker. Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 18 under 35 U.S.C. §103 for at least this reason.

**IV. REJECTION OF CLAIMS 7, 8, 15, AND 19 UNDER 35 U.S.C. §103**

Claims 7, 8, 15, and 19 stand rejected under 35 U.S.C. §103 as being obvious in view of Joong 6,134,433 in combination with Christensen 6,188,758 and further in view of Henrick 6,151,137 and Sladek 6,718,178. These claims depend, respectively, from independent claims 1, 12, and 16 discussed above. As noted *supra*, there is no motivation, suggestion, or reasonable expectation of success in attempting the proposed combination of Joong, Christensen, and Henrick with respect to the claimed inventions. Sladek fails to provide any such motivation. Therefore, for at least the above-discussed reasons, dependent claims 7, 8, 15, and 19 are also patentable over the combination of Joong, Christensen, Henrick, and Sladek, and Applicants request reconsideration and withdrawal of the rejections thereof under 35 U.S.C. §103.

**CONCLUSION**

For at least the above reasons, the currently pending claims 1-20 are believed to be in condition for allowance and notice thereof is requested.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 06-0308, LUTZ200283.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
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3/17/06  
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